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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,511	06/03/1999	HARUHISA SUZUKI	35.G2398	1647
5514	7590	05/03/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/324,511	Suzuki et al.	
	<b>Examiner</b>	<b>Art Unit</b>	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on January 13, 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 66, 68, and 70 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66, 68, and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 3, 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the amendment and arguments filed by applicant on January 13, 2005 in reply to the previous Office action on the merits, mailed October 7, 2004.
2. The amendment of claims 66, 68, and 70 by applicant in the reply filed January 13, 2005 is hereby acknowledged.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 66, 68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. (US 6,324,521).

Shiota et al. disclose a system and method for providing a plurality of services over a network 5, comprising the steps of: transmitting, by a user 1 terminal 6, a request to a service center 2 for printing an image stored on the network 5; storing, by the service center 2 items and their prices in a first table; storing, by the service center, at least one group, each group having a plurality of service providers 3, 4, associated with at least one common item of the first table in a

second table; it being inherent that the stored prices would be updated by the service center to reflect new prices as the prices change over time; calculating, by the service center 2, a charge related to the request by referring to the first and second tables; sending a notification from the service center 2 to the user 1 terminal 6, the notification including the charge calculated in the calculating step; forwarding the request from the service center 2 to an appropriate service provider 3, 4, within the at least one group via the network 5 automatically upon receipt by the service center 2 of an instruction from the user 1 terminal 6 based on the calculated charge; and, performing, by the appropriate service provider 3, 4, printing of the image according to the request received from the service center 2. Shiota et al., though, do not specifically disclose that the receipt by the service center of the instruction from the user terminal of whether to print is in *response* to the notification sent to the user terminal of the calculated charge.

However, informing a customer of the price of a product or service, prior to the customer ordering the product or service, such that the customer can place an order in *response* to knowing the price, should the customer find the price acceptable, is certainly a well known, hence, obvious step to perform in any method of selling goods and/or services.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Shiota et al., so as to inform the customer of the price prior to receiving an order from the customer (if Shiota et al. did not already do so), in order to allow the customer to make an informed decision of whether or not to place the order, as is well known to do, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

*Response to Arguments*

5. Applicant's arguments filed January 13, 2005 have been fully considered but they are not persuasive.

6. Regarding the argument that Shiota et al. fail to disclose storing items and their prices in a first table, Shiota et al. indeed store items and their prices in a first table. Obviously, without doing so, Shiota et al. would be unable to calculate the correct/appropriate charges because the prices would be unknown to the system.

7. Regarding the argument that Shiota et al. fail to disclose storing a group of service providers associated with at least one common item of the first table, in a second table, Shiota et al. indeed disclose storing a group of service providers associated with at least one common item of the first table, in a second table. Otherwise, Shiota et al. would not know which providers provided which services. Also, see, for example, claim 1, lines 2-4 and 9-12 referring to the group of service providers.

8. Regarding the argument that Shiota et al. fail to disclose updating the prices of the items in the first table, one of ordinary skill in the art would instantly recognize that the method and system of Shiota et al. would necessarily, thus inherently, update the prices of the items stored in the first table in order to reflect new prices as the prices changed over time.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to the disclosure.

10. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(571) 272-6788**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

May 2, 2005

 (5-2-05)

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627